

REMARKS

I. Introduction

With the addition of new claims 19 and 20, claims 1, 5, 19 and 20 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

II. Rejection of Claims 1 and 5 Under 35 U.S.C. § 112

Claims 1 and 5 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Final Office Action contends that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Final Office Action at page 2. The Final Office Action states that "[t]he newly added limitation requiring the recited steps to be performed sequentially is not supported by the specification." Final Office Action at page 2. In support, the Final Office Action contends that "steps (c) and (d) in claim 1 and the releasing and gripping steps recited in claim 5 do not appear to happen sequentially." Final Office Action at page 2.

Applicants respectfully disagree and maintain that the recitation in claims 1 and 5 of the steps being performed sequentially is fully supported by the originally-filed Specification and drawings. However, for the purposes of expediting the prosecution of this application, Applicants have amended claim 1 herein without prejudice to delete the recitation that all of the steps are performed sequentially and to instead recite the step of "pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length." Furthermore, Applicants have amended claim 5 herein without prejudice to delete the recitation that all of the steps are performed sequentially and to instead recite the step of "pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length." These amendments are fully supported by the originally-filed Specification and drawings. For instance, the Specification states on page 2, lines 29 to 31, that

"in an ... embodiment the cutting into partial bundles takes place first, and then the cut partial bundles are taken up and transported, using one or more feed elements." Emphasis added.

In view of the foregoing, it is respectfully submitted that claims 1 and 5 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

III. Rejection of Claims 1 and 5 Under 35 U.S.C. § 112

Claims 1 and 5 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Specifically, the Final Office Action contends that "[i]t is not clear what step is set forth sequentially [because] some of the steps do not appear to happen sequentially." Final Office Action at page 2.

As set forth more fully above, Applicants have amended claim 1 herein without prejudice to delete the recitation that all of the steps are performed sequentially and to instead recite the step of "pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length." Furthermore, Applicants have amended claim 5 herein without prejudice to delete the recitation that all of the steps are performed sequentially and to instead recite the step of "pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length." Thus, the claims as amended merely recite that the fiber bundle strands are "pre-cut", and do not recite that all of the steps of the methods are performed sequentially.

In view of the foregoing, it is respectfully submitted that claims 1 and 5 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claim 5 Under 35 U.S.C. § 102(b)

Claim 5 was rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 1,965,464 ("Koehler"). Applicants respectfully submit that Koehler does not anticipate claim 5 as amended for the following reasons.

Claim 5 relates to a method for manufacturing fiber bundles. Claim 5

has been amended herein without prejudice to recite that the method includes the steps of transporting a fiber bundle using at least one feed element and pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length. Claim 5 recites that the method includes the step of releasing the unbound partial bundles from the at least one feed element. Claim 5 also recites that the method includes the step of gripping the unbound partial bundles using at least one gripping element. Claim 5 further recites that the method includes the step of releasing the unbound partial bundles from the at least one gripping element. In addition, claim 5 recites that the method includes the step of placing the unbound partial bundles having the same lengths in a first collection trough of a collection device. Claim 5 also recites that the method includes the step of rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough of the collection device.

Koehler purports to describe a machine for making tassels. Col. 1, lines 1-2. More specifically, Koehler states that "the machine makes tassels of the type in which short sections of threads or cords ... are folded to form an eye and bound together adjacent to the eye by means of a wire ring or staple." Col. 1, lines 2-6.

The Final Office Action states that "Koehler discloses all the recited steps of the invention including: a) transporting a fiber bundle strand using at least one feed element (52, 53); b) cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length (74, 75); c) releasing the unbound partial bundles from the at least one feed element (page 2 lines 72-81); d) gripping the unbound partial bundles using at least one gripping element (65, 66); e) releasing the unbound partial bundles from the at least one gripping element (page 2, lines 82-92); f) placing the unbound partial bundles in first collection trough (26) of a collection device (25); g) rotating the collection trough device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough'." Final Office Action at page 3. The Final Office Action also states that "[e]lement 26 adjacent to the first collection trough (26) is construed as being 'a further collection trough' ... [and] claim 5 does not preclude a step of bounding partial bundles ... [nor does claim 5] call for a step of rotating the collection device while the unbound partial bundles in the first collection trough remains unbound." Final Office Action at page 3.

It is respectfully submitted that Koehler fails to disclose, or even suggest, manufacturing a fiber bundle by pre-cutting a fiber bundle strand into unbound partial bundles and placing the unbound partial bundles having the same lengths in a collection trough, as recited in amended claim 5. In contrast, Koehler describes a process whereby threads or cords are folded to form an eye and are bound together adjacent to the eye by means of a wire ring. More specifically, in Koehler, threads 51 and 54 are fed through tubes 52 and 55, respectively, where they are clamped, folded, etc. Page 2, lines 42-51. After the threads or cords have been bound together to form the tassel, the ends of the threads or cords are cut by knives 74 and 75. Page 2, lines 93-96. Thus, at most Koehler describes that the ends of the threads or cords are cut after the threads or cords are at least 1) clamped, 2) folded, and 3) bound together to form the tassel. Therefore, in Koehler, the tassels are not pre-cut. This is in direct contravention with amended claim 5, which recite manufacturing a fiber bundle by pre-cutting a fiber bundle strand into unbound partial bundles and then placing the unbound partial bundles having the same lengths in a collection trough. Furthermore, Koehler does not disclose or even suggest the step of placing the unbound partial bundles having the same lengths in the same, e.g., a first, collection trough of a collection device until the collection trough is filled prior to rotating the collection device.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Koehler does not disclose, or even suggest, manufacturing a fiber bundle by pre-cutting a fiber bundle strand into unbound partial bundles and then placing the unbound partial bundles having the same lengths in a collection trough, as recited in amended claim 5.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18

U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Koehler does not anticipate claim 5.

V. Rejection of Claim 1 Under 35 U.S.C. §103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Koehler. It is respectfully submitted that Koehler do not render obvious the present claims as amended herein for the following reasons.

Claim 1 relates to a method for manufacturing a fiber bundle having a length from a required number of unbound partial bundles having the same lengths. Claim 1 recites that the method comprises the steps of transporting a fiber bundle strand using at least one feed element. Claim 1 has been amended herein without prejudice to recite that the method includes the step of pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length. Claim 1 also recites that the method includes the steps of releasing the unbound partial bundles from the at least one feed element and gripping the unbound partial bundles using at least one gripping element. In addition, claim 1 recites that the method includes the steps of releasing the unbound partial bundles from the at least

one gripping element and placing the unbound partial bundles in a first collection trough of a collection device. Claim 1 has also been amended herein without prejudice to recite that these steps are repeated for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained in the first collection trough.

The Final Office Action states that "Koehler discloses the invention substantially as claimed including a step of repeating steps a) to f) for the required number of unbound partial bundles (page 2, lines 36-39)." Final Office Action at page 4. The Final Office Action admits that "Koehler fails to disclose repeating the steps a) to f) until a required thickness of the fiber bundle is obtained." Final Office Action at page 4. However, the Final Office Action maintains that "it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to repeat the steps a) to f) until the required thickness of the fiber bundle is obtained (e.g., a required manufacturing amount of bundles) in order to complete a required amount for each containers or collection boxes." Final Office Action at page 4.

It is respectfully submitted that Koehler fails to disclose, or even suggest, the step of pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length, as recited in amended claim 1. In contrast and as set forth more fully above, Koehler describes a process whereby threads or cords are folded to form an eye and are bound together adjacent to the eye by means of a wire ring. Threads 51 and 54 are fed through tubes 52 and 55, respectively, where they are clamped, folded, etc. Page 2, lines 42-51. After the threads or cords have been bound together to form the tassel, the ends of the threads or cords are cut by knives 74 and 75. Page 2, lines 93-96. Thus, at most Koehler describes that the ends of the threads or cords are cut after the threads or cords are at least 1) clamped, 2) folded, and 3) bound together to form the tassel. Therefore, in Koehler, the tassels are not pre-cut. This is in direct contravention with amended claim 1, which recites the step of pre-cutting the fiber bundle strand into unbound partial bundles. Furthermore, Koehler does not disclose or even suggest the step of placing the unbound partial bundles in the same, e.g., a first, collection trough of a collection device until a required thickness of the fiber bundle is obtained in the collection trough.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the

initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As more fully set forth above, it is respectfully submitted that Koehler does not disclose, or even suggest, manufacturing a fiber bundle by pre-cutting a fiber bundle strand into unbound partial bundles, as recited in amended claim 1.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify the reference do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more

prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to combine or modify the references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for combining or modifying the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

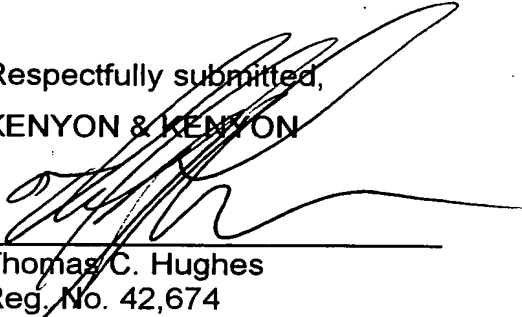
In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone or modified, would provide the features and benefits of claim 1. It is therefore respectfully submitted that claim 1 is allowable for these reasons.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Dated: Nov. 25, 2003

Respectfully submitted,
KENYON & KENYON

By: _____
Thomas C. Hughes
Reg. No. 42,674

One Broadway
New York, New York 10004
(212) 425-7200